

REMARKS/ARGUMENTS

5 Reconsideration of the application is respectfully requested. Claims 1-17 are pending in the present invention. No new matter has been added to the application in this response.

10 1. Rejection of Claims 3, 6, 9-10 and 13 under 35 USC § 112

15 Applicant had already responded to the Section 112 rejection before the Supplemental Action of 27 May 2009 was received. The Examiner is respectfully requested to ignore the comments regarding the Section 112 submitted in the previous response since the Section 112 rejections have now been withdrawn by the Examiner. The rest of the previously submitted response is identical to this response because the Applicant believes the only difference between the 23 February 20 2009 Office action and the 27 May 2009 Office action is the issue related to the Section 112.

2. Rejection of Claims 1-4, 6, 9-10, 12-14 and 16 under 35 USC § 103(a).

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Claims 1-4, 6, 9-10, 12-14 and 16 were rejected under Section 103 as being obvious over Mariana in view of

Chakravorty. This § 103 rejection is respectfully traversed in part and overcome in part as follows:

a. The Requisite Steps of Independent Claim 1 Are Neither Taught Nor Suggested in the Cited Art.

The current amended claim 1 recites, among other method steps, the first management application identifying which first protocol objects correspond to the second protocol object to be managed, the first management application requesting the interface to read or update the corresponding first protocol objects, the interface mapping the corresponding first protocol objects onto the second protocol objects to be managed in an interface database to translate the corresponding first protocol objects into the second protocol understood by the second management application which transmits a signal to the device to perform the management operations of the second protocol objects of the device. Such steps are not taught or suggested in the cited references.

The Examiner correctly states on page 4 of the Office action that Mariana fails to teach a device management system in a mobile network infrastructure. It is submitted that Mariana also fails to teach or suggest the steps of the first management application identifying which first protocol objects correspond to the second protocol object to be management and requesting the interface to update the corresponding first protocol objects, as required by the

amended claim 1. On line 1, page 4 of the Office action, the Examiner interprets the "enclosure HTTP server" of Fig. 3 in Mariana to be equivalent to the first server and the "card HTTP server" to be equivalent to the second server. The third
5 communication node 80 is interpreted to be equivalent to the interface of the current claims. This means Mariana's interface is not distinct and separate from his smart card. In fact, an important feature of Mariana's invention is that the node 80 is in the smart card itself so that it may
10 communicate using the HTTP protocol. An essential feature of Mariana's invention is that his smart card 8 is transformed into a web server and/or client for the secure enclosure 6 and can be addressed by a URL address.

It is submitted that Mariana's node 80 completely
15 fails to teach the step of mapping corresponding first protocol objects onto the second protocol objects in an interface database to translate the first protocol objects into the second protocol. Firstly, node 80 does not have a database and particularly a database that is separate from the
20 smart card. Secondly, there is no teaching of mapping first protocol objects onto second protocol objects. Mariana merely teaches communication at the transport level and the management agents 642 and 842 are not involved in any mapping.

Also, Mariana does not teach the node 80 transmitting a
25 signal to the smart card since the node 80 sits inside the smart card and it would thus not be possible to send a signal

to a smart card that is separate from the node 80, as required by the amended claim 1.

The other cited references do not cure these deficiencies. For example, Kuo merely teaches a smart card management application program that detects if a file name exists on the smart card. It reads the file name and finds the same file name on a local storage 204 on the host computer (see col. 3, lines 7-47). It is submitted that Kuo fails to teach or suggest an interface that maps corresponding first protocol objects onto the second protocol objects to be managed in an interface database to translate the corresponding first protocol objects into the second protocol understood by the second management application. In contrast, Kuo's management application merely identifies a file on the smart card and identifies the same file name in a database. Kuo's management application does not do any mapping to translate the corresponding first protocol objects into the second protocol. Kuo's management application also fails teach the device performing management operations of the second protocol objects of the device. In contrast, Kuo's management application merely identifies the files so that it can look for the files in a database elsewhere.

The cited references are void any discussion of an interface that is distinct and separate from the device (smart card) with second protocol objects to be managed wherein the separate interface maps corresponding first protocol objects

onto the second protocol objects to be managed in an interface database to translate the corresponding first protocol objects into the second protocol, as required by the amended claim 1. To the contrary, Mariana teaches the use of a node (interface) 5 that is built into the smart card and Mariana emphasizes the importance of transforming his smart card into to a web server that can be address by a URL address (bottom of col. 9 and top of col. 10). Similarly, Chakravorty and Kuo fails to teach an interface that is distinct and separate from the device (smart 10 card) that has the second protocol objects to be managed.

Accordingly, the combination of the cited references fails to teach, suggest or provide motivation or incentive for this aspect of the invention. Therefore, the rejection of claim 1 under § 103(a) is improper, and should be removed.

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b. The Requisite Limitations of Independent Claim 12 Are Neither Taught Nor Suggested in the Cited Art.

The requisite limitations of the amended claim 12 20 are submitted to be missing in the cited references for the same reasons and the reasons put forth for the allowability of the amended claim 1 above. Therefore, the rejection of claim 12 under § 103(a) is improper, and should be removed.

25 c. Prima Facie Support for Combination Under § 103 Not Provided

Even assuming *arguendo* that the requisite method steps of claim 1 and the limitations of claim 12 are shown by the combination of Mariana, Chakravorty and the other cited references, *prima facie* support for combining the references, 5 according to the requirements as set forth in M.P.E.P. § 2142 has not been provided in the present Office Action.

As provided in M.P.E.P. § 2142, the Supreme Court in *KSR International v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) specified that the analysis supporting a rejection 10 under 35 U.S.C. § 103 should be made explicit. “[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3dd 977, 988, 78 15 USPQ2d 1329, 1336 (Fed. Cir. 2006). Furthermore, the Examiner must make “explicit” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the 20 background knowledge possessed by a person having ordinary skill in the art” (KSR, page 14).

The only rationale provided in support of the 103(a) rejection of claim 1 is on page 5 of the Office action, which merely asserts it would have been obvious to combine 25 Chakravorty into Mariana “to enable management of digital data and applications over SIM-enabled mobile devices.” (emphasis

added). Thus, the benefit, or advantage of the modification (e.g. enable management etc.) is the only rationale provided in the Office Action in support of the instant rejection.

However, merely stating that the benefit of the
5 modification exists, as done above, does not provide the
"articulated reasoning with some rationale underpinning to
support the legal conclusion of obviousness, required under
KSR. By definition, every patentable invention must be
"beneficial" - and *arguendo* every invention contemplates at
10 least some new benefit(s) in arriving at the invention -
certainly this does not render the benefit obvious or
expected. Because every modification or element has a
corresponding use or benefit, the above reasoning could be
applied to any improvement. It appears therefore that
15 "hindsight construction" may have perhaps played a role in
arriving at the present ground for rejection in the Office
action - which though difficult perhaps to avoid in many
cases, is nonetheless impermissible in making a *prima facie*
showing of obviousness.

20 According to M.P.E.P. 2142, "the examiner bears the
initial burden of factually supporting any *prima facie*
conclusion of obviousness. If the examiner does not produce a
prima facie case, the applicant is under no obligation to
submit evidence of nonobviousness." Because a *prima facie*
25 conclusion of obviousness has not been provided in the present
Office Action, Applicants respectfully request reconsideration

and withdrawal of this ground for rejection as to claims 1 and 12, and any additional remaining claims to the extent they may depend therefrom.

5 d. Dependent Claims 2-4, 6, 9-10, 13-14 and 16

Because dependent claims 2-4, 6, 9-10, 13-14 and 16 depend from the allowable independent claims 1 and 12, respectively, and as detailed above, their rejection is now moot. However, the claims also recite additional characteristics that are not found in the cited art.

Accordingly, the rejection of claims 2-4, 6, 9-10, 13-14 and 16 under § 103(a) is improper.

15 3. Rejection of Claims 5 and 15 under 35 USC § 103(a).

Because dependent claims 5 and 15 depend from the allowable independent claims 1 and 12, respectively, and as detailed above, their rejection is now moot. However, the claims also recite additional characteristics that are not found in the cited art.

Accordingly, the rejection of claims 5 and 15 under § 103(a) is improper.

25 4. Rejection of Claims 7-8, 11 and 17 under 35 USC § 103(a).

Because dependent claims 7-8, 11 and 17 depend from the allowable independent claims 1 and 12, respectively, and as detailed above, their rejection is now moot. However, the claims also recite additional characteristics that are not found in the cited art.

On pages 9-10 of the Office action the Examiner notes it "would have been obvious to assign a URL to a SIM card file as disclosed by Mariana, and implement a relationship between the DM target URL and the SIM file URL."

The above is a mere conclusory statement that the courts have specifically rejected. The statement is prophetic. The rationale of the statement lacks the required explicit and articulated reasoning with some rational underpinning for supporting any *prima facie* conclusion of obviousness.

A rationale for combining Mariana, Chakravorty, DM and Kuo can be found on page 10 where it is stated that the combination is obvious because it would "enable automatically and selectively translate each file, URL, or file reference as they should be when the contents of the smart card are read." Again, this merely states a benefit without the required explicit and articulated reasoning with rational underpinning that explains why the artisan would combine the 4 references to arrive as the present invention. Additionally, the fact that four different references must be combined is an indication that the present invention is not obvious.

Accordingly, the rejection of claims 7-8, 11 and 17 under § 103(a) is improper.

5. Conclusion

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Based on the foregoing, Applicants respectfully request that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the previously amended form of the claims, and that a Notice of Allowance be issued for the present application to pass to issuance.

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In the event any further matters remain at issue
with respect to the present application, Applicants
respectfully request that the Examiner please contact the
5 undersigned below at the telephone number indicated in order
to discuss such matter prior to the next action on the merits
of this application.

The application is submitted to be in condition for
allowance, and such action is respectfully requested.

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Respectfully submitted,

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